



Paper No. 14

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**FEB 28 2003**

**OFFICE OF PETITIONS**

JOHN S. BEULICK  
ARMSTRONG TEASDALE LLP  
ONE METROPOLITAN SQUARE  
SUITE 2600  
ST. LOUIS, MO 63102

In re Application of  
Holmes et al.  
Application No. 09/754,600  
Filed: January 5, 2001  
Attorney Docket No. 9D-HR-19406

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ON PETITION

This decision concerns the "Petition for Withdrawal of Holding of Abandonment or, in the Alternative, for Revival of an Unintentionally Abandoned Patent Application," filed on May 30, 2002, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment for the above-identified application and, alternatively, a petition under 37 CFR 1.137(b) to revive this application.

The petition under 37 CFR 1.181 is **DISMISSED**.  
The alternative petition under 37 CFR 1.137(b) is **DISMISSED**.

This application became abandoned on April 22, 2001 for failure to timely respond to the February 21, 2001 Notice to File Missing Parts of Nonprovisional Application ("2/21/01 Notice"), which provided an extendable 2-month reply period. No extension of time under 37 CFR 1.136(a) was obtained.<sup>1</sup>

### **§1.181 petition**

The petition requests withdrawal of the holding of abandonment on the basis that the 2/21/01 Notice was not received by General Electric Company ("GE").

A grantable petition to withdraw the holding of abandonment, alleging non-receipt of an Office action which is the cause of the abandonment, must overcome a strong presumption that the Office action at issue, duly addressed and indicated as mailed, was timely delivered to the addressee.<sup>2</sup>

The showing required to overcome this presumption consists of:<sup>3</sup>

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<sup>1</sup> The due date, 4/21/01, was a Saturday. Under 37 CFR 1.7(a), a proper response filed on or before 4/23/01 (Monday) would have been considered "timely." However, failure to do so renders the application abandoned as of 4/22/01.

<sup>2</sup> 1156 OG 53 (Oct. 25, 1993).

<sup>3</sup> *Id.*

- (1) a statement from the practitioner:
  - stating that the Office action was not received by the practitioner;
  - attesting, by referencing the docket record in (2) below, that a search of the relevant file jacket and docket records indicates that the Office action was not received; and
- (2) a copy of the docket record where the allegedly non-received Office action would have been docketed had it been received.

Notwithstanding the fact that the instant petition contains essentially the requisite showing as delineated above, the 2/21/01 Notice was addressed and mailed to GE at the correspondence-address-of-record at that time: Appliance Park, 2-225, Louisville, KY 40225.<sup>4</sup> If the file was subsequently transferred to GE's outside counsel, that the 2/21/01 Notice is not presently in the transferred file does not establish GE's non-receipt of the 2/21/01 Notice; nor does it rule out the possibility that the 2/21/01 Notice had been received by GE but was never docketed.<sup>5</sup> The §1.181 petition is thus dismissed and the holding of abandonment in this application will not be withdrawn. No petition fee is owed.

#### **§1.137(b) petition**

Under 37 CFR 1.137(b), a grantable petition to revive an abandoned application must be accompanied by: (1) **the required reply**, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m);<sup>6</sup> (3) a statement that the entire delay in filing the required reply from its due date until the filing of a grantable §1.137(b) petition was unintentional;<sup>7</sup> and (4) a terminal disclaimer for a utility application filed before June 8, 1995.<sup>8</sup>

In reply to the 2/21/01 Notice, the petition encloses a signed Declaration and Power of Attorney, and 71 sheets of substitute drawings. However, some of the substitute drawings do not comply with the requirements of 37 CFR 1.84 as explained in the attached Notice of Draftsperson's Patent Drawing Review. The petition is thus dismissed for failing to meet the threshold requirement of 37 CFR 1.137(b).

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<sup>4</sup> A request to change the correspondence address for this application to the current outside counsel was not filed until 12/18/01, 10 months later.

<sup>5</sup> See MPEP section 711.03(c)(II) (Aug. 2001).

<sup>6</sup> Enclosed with petition.

<sup>7</sup> Included in petition.

<sup>8</sup> Not applicable to this application.

A renewed §1.137(b) petition (**no fee**) must be:

- accompanied by:
  - necessary substitute drawings in compliance with 37 CFR 1.84;<sup>9</sup> **and**
  - a **statement** that the entire delay in filing the required drawings from the due date until the filing of a grantable §1.137(b) petition was unintentional;
- filed within **TWO MONTHS** of the mailing date of this decision unless proper extension(s) of time is (are) obtained under 37 CFR 1.136(a);<sup>10</sup>

and should be addressed (**by mail or by hand**) to:<sup>11</sup>

Assistant Commissioner for Patents  
USPTO, Office of Petitions  
Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

Finally, the Office acknowledges receipt with the instant petition of the \$130 surcharge for late filing of the declaration.

Telephone inquiries may be directed to the undersigned at (703) 308-0763.



RC Tang  
Petitions Attorney  
Office of Petitions

Attachment: 2/27/03 Notice of Draftsperson's Patent Drawing Review (courtesy copy)

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<sup>9</sup> Only the sheets of drawings that were objected to by the draftsman need to be substituted for.

<sup>10</sup> 37 CFR 1.137(e)(1).

<sup>11</sup> Filing by facsimile is not an option since drawings are involved.